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#11/Reply
Brief
R. Tyson
12/7/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Amendment/Response Transmittal

IBM Docket No. EN9-91-022R (IEN-10-5342-R)

In re application of: Gedney et al

Serial No.: 09/004,524

Filed: January 8, 1998

For: IC CHIP ATTACHMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is a **Reply Brief (in triplicate)** in the above-identified Application.

- No additional fee is required.
- The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 09-0457. A duplicate copy of this sheet is enclosed.
- Any additional filing fees required under 37 C.F.R. §1.16.
- Any patent application processing fees under 37 C.F.R. §1.17.

Respectfully submitted,

CERTIFICATE OF MAILING UNDER 37 CFR 1.8	
I hereby certify that I am depositing the enclosed or attached correspondence with the United States Postal Service as First Class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.	
on <u>November 17, 2000</u>	
Carole Giacomazzo	
Name of person mailing paper	
<u>Carole Giacomazzo</u> <u>11-17-00</u>	
Signature	Date

By: William N. Hogg 11-17-00
William N. Hogg, Reg. No. 20,156
DRIGGS, LUCAS, BRUBAKER & HOGG CO., L.P.A.
8383 Mentor Avenue
Mentor, Ohio 44060
(440) 205 3600
Fax: 440 205 3601

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gedney et al)
Serial No. 09/004,524)
Filed: January 8, 1998) Examiner: J. Vigushin
For: **IC CHIP ATTACHMENT**) Art Unit: 2835
Reissue of U.S. Patent No. 5,483,421)
Attorney Docket No. IEN-10-5342-R)
(EN9-91-022R))

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REPLY BRIEF

Noted by Examiner John B. Vigushin on December 06, 2000
Board of Patent Appeals
Assistant Commissioner for Patents
Washington, D. C. 20231

Dear Sir:

I. RELATED APPEALS AND INTERFERENCES

The undersigned attorney is not aware of other appeals or interferences which would directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

II. RESPONSE TO EXAMINER'S ARGUMENT

The Examiner indicated that the section identifying related appeals and interferences was not contained in the Appellants' brief. A review of the brief indicated that it was included. However, this section has been set out again in this Reply Brief.

(2) The Examiner states on page 4 of the Examiner's Answer "the present Examiner now realizes that the presence, in reissue Claims 21 and 34, of the limitation of "an encapsulation material encapsulating said first set of solder connections" has no bearing on the matter of recapture now before the Board. The present examiner believes that both he and the Appellants have been pursuing the wrong line of argument in **comparing the reissue Claims 21 and 34 to Claims 1 and 7 as originally filed in Application '467**. The fact that Claims 21 and 34 are **narrower compared to the originally filed Claims 1 and 7** (in the aspect of the above-cited encapsulation material, and **broader compared to the amended (patented) Claims 1 and 7** (in the aspect of both the specific chip carrier material, i.e., the glass filled epoxy, and the range of coefficients of thermal expansion of the chip carrier, i.e., at least 17 x 10⁶ PPM/°C) has no relevance to the recapture issue as it applies to Claims 21-25 and 34 of the instant reissue Application 09/004,524 now before the Board." (Emphasis original) The Examiner goes on to state: "The sole issue upon which recapture depends in the instant Reissue Application is the **broadening of the patented** claims of Application '467 in aspects that were vigorously argued by the Appellants,..." The examiner also states on page 10 of the brief "Regardless of whether or not the "encapsulation material" limitation in reissue Claims 21-25 and 34 is or is not a patentable feature of the claims, the attempt to recapture the surrendered subject matter as discussed in paragraph (VII), above, precludes examination of Claims 21-25 and 34 on the merits and requires the rejection of Claims 21-25 and 34 under 35 USC § 251."

Appellants respectfully disagree with these premises now initially offered by the Examiner. It is submitted that the examiner is presenting the issue as if the recapture doctrine relates solely to whether the claims are broader in some aspects than the issued claims and totally ignores whether

the claims are narrower in scope than the originally filed claims. Thus, the examiner is presenting a recapture argument based solely on the aspect of a broadening reissue when the claims are broader in some aspects and narrower in others than the issued claims allowed. However, this is not the proper test for recapture. It is admitted that this is, in fact, a broadening reissue and it is admitted that the claims are broader in some aspects and narrower in others than the issued claims. However, the requirements for broadening the reissue have been met and, thus, this is not at issue herein. The sole issue as indicated by the examiner is whether the doctrine of recapture applies.

The doctrine of recapture is succinctly stated in Ball Corporation v. United States, 729 F 2d 1429 (CAFC 1984) at page 1436 as follows:

“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application.” (emphasis original)

The court compares this to the broadening reissue rule at page 1436 as follows:

“If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent.”

The proper application of the recapture doctrine is set out in Ball Corporation, supra at page 1437: “The trial judge required the government to establish that the applicant has made a deliberate decision that the canceled claims are unpatentable. The Government argues that that standard is not correct because it loses sight of the *feature* that the patentee gave up during prosecution of the original application. We find the government’s argument entirely unpersuasive. The proper focus is on *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application. The trial judge quite properly focused on the scope of the claims and we find no error in this respect.” The court

at the same page then clearly sets out the proper result of this rule. "He [the trial Judge] determined that the reissue claims were intermediate in scope—broader than the claims of the original patent yet narrower than the canceled claims."

This is precisely the case here. The claims here are broader than the claims of the original patent yet narrower in scope than the canceled claims. Thus, the examiner's statement "the fact that Claims 21 and 34 are narrower compared to the originally filed Claims 1 and 7...has no relevance to the recapture issue as it applies to Claims 21-25 and 34..." is clearly not an accurate statement of the test to be applied for recapture. Indeed, the proper test is just the opposite from what the examiner states. The recapture doctrine requires a comparison of the claims on appeal to the scope of the canceled claims. The scope of the claims on appeal is clearly narrower than the scope of canceled claims in that the claims on appeal require an encapsulation material whereas the canceled claims do not. The fact that certain features or elements were given up during prosecution is irrelevant as stated in the Ball decision quoted, *supra*.

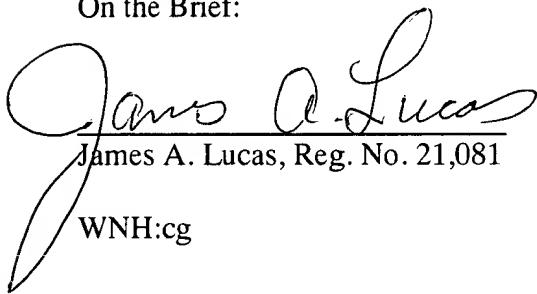
Because the giving up of individual features or elements as opposed to giving up the scope of the claims is irrelevant, the examiner's discussion of the Board's holding as to the various features and elements and their bearing on the claims as allowed is not relevant since no originally filed claims of the same scope or narrower than those presented herein were canceled. The Examiner admits that the claims are not of the same scope as originally filed since he admits that the limitation for an encapsulation material... is not in the original and canceled claims. Thus the recapture doctrine clearly does not apply since the claims herein are not of the same scope as those given up.

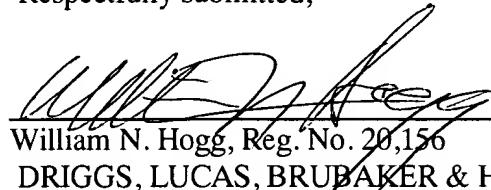
3) Again, it is submitted that the Appellants are merely urging that there be an action on the merits of the claims of the reissue application as to their patentability over any proper prior art, which action is urged.

Respectfully submitted,

Date: 11/17/00

On the Brief:


James A. Lucas, Reg. No. 21,081
WNH:cg


William N. Hogg, Reg. No. 20,156
DRIGGS, LUCAS, BRUBAKER & HOGG CO., L.P.A.
Old Village Hall
8383 Mentor Avenue
Mentor, Ohio 44060
(440) 205-3600
Fax: 440-205-3601